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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/088,090      | 06/21/2002  | Stephen Arkinstall   | 220316USOPCT        | 7121             |

22850 7590 09/03/2004

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ALEXANDRIA, VA 22314

EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/088,090

Applicant(s)

ARKINSTALL ET AL.

Examiner

Celia Chang

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on 18 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,7-9,17-19 and 29-40.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

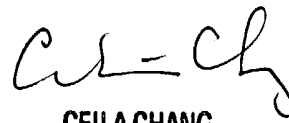
  
Celia Chang  
Primary Examiner  
Art Unit 1625

Art Unit: 1625

*ATTACHMENT TO ADVISORY*

The after final amendment will not be entered for the following new issues and new matters:

1. Please note that the “scope” as now amended in claim 1 is considered to contain new matter. It has been clearly explained in the final rejection that no “subgenus” being drawn to the amendment finds antecedent basis in the specification. The preferred choices in certain Markush elements did not support the picking and choosing of the particular combination of the instant amended claim 1, thus, lacking of antecedent basis. Specifically, attention is drawn to page 11 lines 11-12, no support can be found for the R6 is limited to the scope as claimed with one or more substituents....etc. There is no support why applicants employed the scope of Ar1 is “unsubstituted phenyl or phenyl substituted with one or more substituents selected from the group consisting of substituted or unsubstituted.....” and not the preferably 4-chlorophenyl group. The specific compounds as claimed in claim 9 which finds antecedent basis on page 12, does not provide support for the subgenus as now constructed by picking and choosing certain preferred choices of the elements without the antecedent basis for such subgeneric description.
2. The changing of modulating to “down regulate or inhibit” of claim 33 does not obviate the 101 and 112 issues of record but introduce new matter and new issues which would be considered reach through claims and incredible utility.
3. Newly added claim 41 lacks antecedent basis in the specification, because at page 11 lines 28 to page 12 line 7, the description was not limited to the subgeneric scope as now claimed particularly, please note that the specific choices of R6 is when R5 is hydrogen only, and not other element was limited.
4. Newly added claims 42-45 are considered reach through claims and is incredible since treating all cancer is incredible and myocardial infarction is irreversible.
5. The rejections under 102 and 103 of record are maintained since removing new matter, the rejections still are applicable.

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200 (625)